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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,567	11/20/2001	Constance A. Williams	S00064/70000 (DW)	8745
23628	7590	03/03/2006		
WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2206			EXAMINER TARAE, CATHERINE MICHELLE	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/988,567	Applicant(s) WILLIAMS, CONSTANCE A.	
	Examiner C. Michelle Tarae	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>March 5, 2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on November 20, 2001. Claims 1-9 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the publications supplied in the Information Disclosure Statement (IDS) provided on March 5, 2002.

Claim Objections

3. Claim 3 is objected to because of the following informalities: Claim 3 has the phrase, "encoded messages," underlined. The underlining should be removed from the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1 and 2 recite the limitations, "to derive possible meanings of each answer" and "synthesizing the derived meanings," and independent claim 3 recites the limitation, "to hypothesize reasons consumers may be motivated." Claim 5 recites the limitation, "questions that are provocative, raise provocative notions, do not have direct relevance to the item of interest, and have analogous and indirect relevance to the item of interest." These limitations are representative of subjective steps that may be performed in the mind of the user, thus raising the issue of abstract ideas that require undue experimentation for the invention to be performed. Since many of the steps of the claims use subjective questions to gather subjective answers, which are evaluated subjectively and lack a concise formula or description for how to evaluate the answers, one skilled in the art would have to conduct undue experimentation in order to perform the invention. Therefore, claims 1-9 are considered as failing to comply with the enablement requirement.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "wherein the solicitations of nuggets" and claim 8 recites the limitation "analyzing the geodes."

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to MPEP 2106, the claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application in order to be considered statutory.

Independent claim 1 recites the limitation “elicit answers... from... visual images, metaphors and analogies having no direct relevance to the product or service.” Independent claims 1 and 2 recite the limitations “to derive possible meanings of each answer” and “synthesizing the derived meanings.” Independent claim 3 recites the limitation “to hypothesize reasons consumers may be motivated.” Claim 5 recites the limitation “questions that are provocative, raise provocative notions, do not have direct relevance to the item of interest, and have analogous and indirect relevance to the item of interest.” These example limitations do not appear to be able to be reproduced and achieve the same or predictable results after each reproduction as they are related to using subjective questions that gather subjective answers which are evaluated subjectively. A consumer being asked the questions may provide different responses to the same questions at different times. Likewise, the answers may be evaluated in a different fashion at different times. Therefore, the claims do not appear to produce predictable or reproducible results and are thus, not considered concrete.

Additionally, the limitations discussed above are also considered not tangible as they do not provide a "real world" result to the user. For example, they do not actually display or provide to the user the determined motivations of consumers as recited in the preamble as being the objective of the invention.

Therefore, claims 1-9 are considered not concrete and not tangible and are thus, directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mick et al., "A projective study of motivations and meanings of self-gifts: implications for retail management," *Journal of Retailing*, 1992.

As per claim 1, Mick et al. discloses a method for determining marketplace motivation of consumers of a product, brand or service comprising selecting a group representative of consumers of the product, brand or service (last two paragraphs on page 2; A group of women were selected as a focus group for analyzing consumer motivations for perfume purchases.), conducting one or more discovery sessions with the group wherein a series of questions relative to the product or service are presented to the consumers in the sample to elicit answers, said questions including those

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intended to elicit answers selected from a group comprising visual images, metaphors and analogies having no direct relevance to the product or service (page 3; The women were asked to tell a story relating to pictures shown to them. The women also filled out a survey.), collecting said answers into a database (last paragraph on page 2; page 4; The women's responses were collected in an audio-recorder and on a survey form. The women's stories were also collected and transcribed for analyses.), evaluating thereafter each answer relative to the product, brand or service to derive possible meanings of each answer (page 4; After the women's stories were transcribed, they were analyzed to derive meanings.), and collecting the possible meanings into a further database, thereafter forming separate subgroups of the group for separately analyzing the derived meanings to synthesize a plurality of derived meanings into a pattern or theme relative to the product or service (page 4; The stories were first categorized into seven categories based on story content and then further categorized into three more categories based on story grammar.), thereafter creating a set of subgroups from the original group, with said new set of subgroups further synthesizing the derived meanings into meanings relative to marketplace motivations of the consumers of the product or service (page 4; The final categories of stories were further analyzed based on prior findings and prior marketing and psychological research.).

As per claim 4, Mick et al. discloses a method as set forth in claim 1 wherein the consumers are evaluated using a focus group and facilitator (last two paragraphs on page 2; A group of women were selected as a focus group for analyzing consumer motivations for perfume purchases.).

As per claim 5, Mick et al. discloses a method as set forth in claim 4 wherein the solicitations of nuggets involves questions that are selected from a group of questions that are provocative, raise provocative notions, do not have direct relevance to the item of interest, and have analogous and indirect relevance to the item of interest (page 3; The women were asked to tell a story relating to pictures shown to them. The pictures were a part of a Thematic Apperception Test (TAT), which is intended to provoke irrational or emotional responses from test subjects based on fictitious characters or circumstances.).

As per claim 6, Mick et al. discloses a method as set forth in claim 5 wherein answers to questions are recorded without editorializing or paraphrasing the response (last paragraph on page 2; The women's responses were collected in an audio-recorder and on a survey form.).

As per claim 7, Mick et al. discloses a method as set forth in claim 5 wherein the evaluation of the nuggets further involves steps selected from the group comprising drawing pictures, creating collages, role playing, and posing paradoxes (page 3; The women were asked to tell a story relating to pictures shown to them.).

As per claim 8, Mick et al. discloses a method as set forth in claim 1 wherein analyzing geodes involves synthesizing and converging existing geodes into insights of new patterns and combinations of terms having relevance to the item in question (page 4; The women's responses/stories were analyzed for similarities and differences and then grouped according to themes/patterns related to purchasing perfume.).

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As per claim 9, Mick et al. discloses a method as set forth in claim 8 wherein the insights are further synthesized to achieve a rational or meaning more directly relating the previously defined insight into an insight directly relevant to consumer interest in the item (page 4; top of page 7; last paragraph on page 8; last two paragraphs on page 9; The women's responses/stories were analyzed for similarities and differences and then grouped according to themes/patterns related to purchasing perfume. Insights suggesting brand and cost motivations relevant to purchasing perfume were derived from analyzing the women's stories.).

Claims 2 and 3 recite substantially similar subject matter as claims 1 and 4-9 above. Therefore, claims 2 and 3 are rejected on the same basis as claims 1 and 4-9 above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Clarke et al. "Thinking the thoughts they do: symbolism and meaning in the consumer experience of the 'British pub'," *Qualitative Market Research*, 1998 [retrieved from Dialog] discusses symbolism and meaning in the consumer experience;

- Harvey et al. "Decoding competitive propositions: A semiotic alternative to traditional advertising research," *International Journal of Market Research*, 2001 [retrieved from Dialog] discusses semiotic research in advertising;
- Binstock, Jeanne. "Trends, symbols and *brand power in global markets: The business anthropology approach*," *Strategy & Leadership*, 1996 [retrieved from Dialog] discusses analyzing semiotics in consumer research;
- McQuarrie et al. "Figures of rhetoric in advertising language," *Journal of Consumer Research*, 1996 [retrieved from Dialog] discusses figure of speech in advertising;
- Englis et al. "To be and not to be: Lifestyle imagery, reference groups, and the clustering of America," *Journal of Advertising*, 1995 [retrieved from Dialog] discusses imagery in advertising;
- Spotts et al. "Assessing the use and impact of humor on advertising effectiveness: A contingency approach," *Journal of Advertising*, 1997 [retrieved from Dialog] discusses using humor in advertising;
- McQuarrie et al. "On Resonance: A Critical Pluralistic Inquiry Into Advertising Rhetoric," *The Journal of Consumer Research*, 1992 [retrieved from JSTOR] discusses figure of speech in advertising;
- Mick, David. "Consumer Research and Semiotics: Exploring the Morphology of Signs, Symbols, and Significance," *The Journal of Consumer Research*, 1986 [retrieved from JSTOR] discusses semiotics in consumer research;

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- Ligas, Mark. "People, Products, and Pursuits: Exploring the Relationship between Consumer Goals and Product Meanings," *Psychology & Marketing*, 2000 [retrieved from Internet] discusses symbolism in products;
- Gregan-Paxton et al. "Consumer Learning by Analogy: A Model of Internal Knowledge Transfer," *The Journal of Consumer Research*, 1997 [retrieved from JSTOR] discusses consumer learning using analogies;
- Frost (U.S. 5,041,972) discusses a method of evaluating consumer responses;
- Sack (U.S. 5,124,911) discusses a method of evaluating consumer choice through concept testing; and
- Fuisz et al. (U.S. 6,718,310) discusses a method for determining customer motivations in purchasing decisions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. Michelle Tarae
Patent Examiner
Art Unit 3623

February 22, 2006